



SEP 5 2001

In re

:  
: DECISION ON  
: PETITION FOR REGRADE  
: UNDER 37 C.F.R. § 10.7(c)  
:**MEMORANDUM AND ORDER**

(petitioner) petitions for regrading her answers to questions 1 and 50 of the morning section and questions 2, 21, 33 and 47 of the afternoon section of the Registration Examination held on October 18, 2000. The petition is denied to the extent petitioner seeks a passing grade on the Registration Examination.

**BACKGROUND**

An applicant for registration to practice before the United States Patent and Trademark Office (USPTO) in patent cases must achieve a passing grade of 70 in both the morning and afternoon sections of the Registration Examination. Petitioner scored 64. On January 19, 2001, petitioner requested regrading, arguing that the model answers were incorrect.

As indicated in the instructions for requesting regrading of the Examination, in order to expedite a petitioner's appeal rights, a single final agency decision will be made regarding each request for regrade. The decision will be reviewable under

35 U.S.C. § 32. The Director of the USPTO, pursuant to 35 U.S.C. § 2(b)(2)(D) and 37 CFR 10.2 and 10.7, has delegated the authority to decide requests for regrade to the Director of Patent Legal Administration.

### **OPINION**

Under 37 C.F.R. § 10.7(c), petitioner must establish any errors that occurred in the grading of the Examination. The directions state: " No points will be awarded for incorrect answers or unanswered questions." The burden is on petitioners to show that their chosen answers are the most correct answers.

The directions to the morning and afternoon sections state in part:

Do not assume any additional facts not presented in the questions. When answering each question, unless otherwise stated, assume that you are a registered patent practitioner. Any reference to a practitioner is a reference to a registered patent practitioner. The most correct answer is the policy, practice, and procedure which must, shall, or should be followed in accordance with the U.S. patent statutes, the PTO rules of practice and procedure, the Manual of Patent Examining Procedure (MPEP), and the Patent Cooperation Treaty (PCT) articles and rules, unless modified by a subsequent court decision or a notice in the Official Gazette. There is only one most correct answer for each question. Where choices (A) through (D) are correct and choice (E) is "All of the above," the last choice (E) will be the most correct answer and the only answer which will be accepted. Where two or more choices are correct, the most correct answer is the

answer which refers to each and every one of the correct choices. Where a question includes a statement with one or more blanks or ends with a colon, select the answer from the choices given to complete the statement which would make the statement true. Unless otherwise explicitly stated, all references to patents or applications are to be understood as being U.S. patents or regular (non-provisional) utility applications for utility inventions only, as opposed to plant or design applications for plant and design inventions.

Where the terms “USPTO” or “Office” are used in this examination, they mean the United States Patent and Trademark Office.

Petitioner has presented various arguments attacking the validity of the model answers. All of petitioner's arguments have been fully considered. Each question in the Examination is worth one point.

Petitioner has been awarded an additional point for morning question 50. Accordingly, petitioner has been granted an additional point on the Examination. No credit has been awarded for morning question 1 and afternoon questions 2, 21, 33 and 47. Petitioner's arguments for these questions are addressed individually below.

Morning question 1 reads as follows:

1. Regarding the specification of a nonprovisional patent application, which of the following practices is in accordance with proper USPTO practice and procedure?

- (A) The specification may include graphical illustrations or flowcharts.
- (B) The specification may include tables and chemical formulas.
- (C) The specification may include hyperlinks or other forms of browser-executable code embedded in the text.
- (D) The specification must begin with one or more claims.
- (E) The specification may include a reservation for a future application of subject matter disclosed but not claimed in the application.

The model answer is choice B.

MPEP § 608.01, subsection “Illustrations In the Specification.” 37 C.F.R. § 1.58(a) permits tables and chemical formulas in the specification in lieu of formal drawings. (A) is incorrect. MPEP § 608.01, subsection “Illustrations In the Specification.” Graphical illustrations, diagrammatic views, flowcharts, and diagrams in the descriptive portion of the specification do not come within the purview of 37 C.F.R. § 1.58(a). The examiner should object to such descriptive illustrations in the specification and request formal drawings in accordance with 37 C.F.R. § 1.81 when an application contains graphs in the specification. (C) is incorrect. MPEP § 608.01, subsection “Hyperlinks And Other Forms Of Browser-Executable Code In The Specification.” USPTO policy does not permit the USPTO to link to any commercial sites since the USPTO exercises no control over the organization, views, or accuracy of the information contained on these outside sites. (D) is incorrect. 37 C.F.R. § 1.75(a). The specification must conclude with one or more claims. (E) is incorrect. 37 C.F.R. § 1.79. A reservation for a future application of subject matter disclosed but not claimed in a pending application will not be permitted in the pending application.

Petitioner argues that answer (A) is correct. Petitioner contends that drawings are also part of the specification, pointing to form paragraphs 6.01 and 6.02.

Petitioner’s arguments have been fully considered but are not persuasive.

Contrary to petitioner's statement that drawings are also part of the specification, pointing to form paragraphs 6.01 and 6.02, MPEP 608.01 states "Therefore, **the specification**, including any claims, may contain chemical formulas and mathematical equations, but **should not contain drawings or flow diagrams or diagrammatic views of chemical structures**. The description portion of the specification may contain tables; claims may contain tables only if necessary to conform to 35 U.S.C. 112." Accordingly, model answer (B) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 2 reads as follows:

2. Which of the following is not a proper incorporation by reference in an application prior to allowance according to USPTO rules and procedures?

(A) Incorporating material necessary to describe the best mode of the claimed invention by reference to a commonly owned, abandoned U.S. application that is less than 20 years old.

(B) Incorporating non-essential material by reference to a prior filed, commonly owned pending U.S. application.

(C) Incorporating material that is necessary to provide an enabling disclosure of the claimed invention by reference to a U.S. patent.

(D) Incorporating non-essential material by reference to a hyperlink.

(E) Incorporating material indicating the background of the invention by reference to a U.S. patent which incorporates essential material.

The model answer is selection D.

MPEP § 608.01(p). (A) is incorrect because abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications. (B) is incorrect because non-essential material may be incorporated by reference to patents or applications published by the United States. (C) is incorrect because material necessary to provide an enabling disclosure is essential material, which may be incorporated by reference to a U.S. patent. (E) is incorrect because non-essential material may be incorporated by reference to a U.S. patent which incorporates essential material.

Petitioner argues that answer (A) is also correct. Petitioner contends that (A) would not be a proper incorporation where the application incorporated was pending during prosecution but has not issued under MPEP 1302.04.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that that (A) would not be a proper incorporation where the application incorporated was pending during prosecution but has not issued under MPEP 1302.04, the portion of the MPEP petitioner paraphrases is from MPEP 608.01(p)(A), which also states that abandoned applications less than 20 years old can be incorporated by reference to the same extent as copending applications, therefore rendering (A) as a proper incorporation. The portion of the MPEP directing an examiner to require inclusion of the referenced material does not negate the propriety of the incorporation. Accordingly, model answer (D) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 21 reads as follows:

21. You are prosecuting a patent application wherein an Office action has been issued rejecting the claims as being obvious over the prior art and objecting to the drawings as failing to illustrate an item that is fully described in the specification and included in a dependent claim. The examiner has required an amendment to Figure 1 to illustrate the item. In preparing a reply to the Office action, you identify several errors in Figure 2 that should also be corrected. Assuming that you make an amendment to the claims and develop persuasive arguments to overcome the obviousness rejection and that the examiner will not object to your desired changes to Figure 2, which of the following actions is likely to lead to the most favorable result?

(A) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. Submit a separate cover letter for replacement Figures 1 and 2 that incorporate the amendments to the drawings.

(B) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In the Remarks portion of the reply, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(C) Submit a reply amending the claims and setting forth your arguments to overcome the obviousness rejection. In a separate paper, explain the proposed drawing changes and attach copies of Figures 1 and 2 with the changes marked in red for the examiner's review and approval.

(D) Options (A), (B) and (C) are equally likely to lead to the most favorable result.

(E) Options (B) and (C) are equally likely to lead to the most favorable result.

The model answer is selection C.

(A) is not the best answer because drawing changes normally must be approved by the examiner before the application will be allowed. The examiner must give written approval for alterations or corrections before the drawing is corrected. MPEP § 608.02(q). (B) is not the best answer because any proposal by an applicant for amendment of the drawing to cure defects must be embodied in a separate letter to the draftsman. MPEP § 608.02(r). (D) is not the best answer because it incorporates (A) and (B), and (E) is not the best answer because it incorporates (B).

Petitioner argues that answer (E) is correct. Petitioner contends that the Office accepts drawing amendments either incorporated in the response to an Office action or as a separate paper, relying on the phrase "should be in a separate paper" in 37 C.F.R. §§ 1.121(a)(3)(ii) as contrasted with "must".

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that the Office accepts drawing amendments either incorporated in the response to an Office action or as a separate paper, MPEP § 608.02(r) states that any correction must be embodied in a separate letter. Accordingly, model answer (C) is correct and petitioner's answer (B) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 33 reads as follows:

33. Mike and Jill are members of the Virginia Bar with a general law practice. Jill is registered to practice before the USPTO and is constantly poking fun at Mike for not being registered. Jake, one of Mike's former clients, owns a small tool shop and while

attempting to remove a broken drill bit from a workpiece, invented a tool that easily extracts a broken bit. The tool is simple to make. Jake asked Mike if he could patent his invention, and Mike, desiring to impress Jill with his patent skills, said, "No problem." Using a "how to" book that he obtained from the INTERNET, Mike prepared an application on Jake's invention and filed it in the USPTO together with a power of attorney which Jake executed naming Jack as attorney of record. Shortly thereafter, the Mike and Jill firm hired Jim, a registered patent attorney, and Mike physically filed a document with the USPTO naming Jim as an associate attorney in Jake's application. Upon reviewing Jake's application, Jim discovered that the original claims omitted the recitation of a critical element which was disclosed in the specification. Assuming a preliminary amendment is filed with the USPTO adding the critical element to the claims, and explaining in the REMARKS that the critical element was inadvertently omitted at the time of filing the application, which of the following is the most comprehensive answer in identifying the individual(s), if any, who by signing the amendment will be recognized by the USPTO for representation?

- (A) Jake
- (B) Jim
- (C) Jill
- (D) All of the above
- (E) None of the above

The model answer is selection D.

Jake is the applicant, and Jim and Jill are registered practitioners. "An applicant for patent may file and prosecute his or her own application... ." MPEP § 401. The applicant, Jake, is not required to revoke Mike's power of attorney because Jack is unregistered, and therefore his appointment is void ab initio. MPEP § 402, Form Paragraph 4.09 (first paragraph). Jim and Jill's signature constitutes "a representation to the Patent and Trademark Office that...he or she is authorized to represent the particular party in whose behalf he or she acts." 37 C.F.R. § 1.34. This privilege applies whether or not the registered attorney is of record. 37 C.F.R. § 1.31; MPEP § 402. (A), (B), and (C) are wrong because they do not represent the "most comprehensive" answer. (E) is wrong because it is inconsistent with (D), which is correct.

Petitioner argues that no answer is correct. Petitioner contends that neither Jim nor Jill were properly appointed, but that an answer of Jake or Jill would be correct because Jake is an applicant and Jill was a registered agent hired represent Jake.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that neither Jim nor Jill were properly appointed, the



question asks who by signing the amendment will be recognized by the USPTO for representation; the question does not ask who is properly appointed. Both Jim and Jill will be recognized. See 37 C.F.R. § 1.34. Accordingly, model answer (D) is correct and petitioner's answer (A) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

Afternoon question 47 reads as follows:

47. A patent application filed in the USPTO contains the following three original claims, including product by process Claim 3:

Claim 1. A method for making an Ethernet cable comprising the steps of A, B and C.

Claim 2. The method of claim 1, further characterized by the step of D.

Claim 3. The Ethernet cable as in any one of the preceding claims.

In the first Office action, the examiner objects to Claim 3 as being an improper dependent claim and requires cancellation of the claim. Following proper USPTO practices and procedures, which of the following replies best overcomes the examiner's objection and provides the client with the broadest patent protection?

(A) Amend Claim 3 to read: "The Ethernet cable as made by the process set forth in claims 1-2."

(B) Cancel Claim 3.

(C) Cancel Claim 3 and add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C."

(D) Cancel Claim 3 and add Claim 5, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."

(E) Cancel Claim 3. Add Claim 4, which reads: "An Ethernet cable made by a process comprising the steps of A, B and C." Add Claim 5, which reads: "An Ethernet cable made by a process comprising the steps of A, B, C and D."

The model answer is selection E.

The cancellation of Claim 3 overcomes the examiner's objection. The addition of

Claims 4 and 5 provide the client with patent protection in product by process format for the cable by both methods of manufacture. Thus, if Claim 4 is invalid, Claim 5 may remain valid. Answer (A) is incorrect because it is an improper multiple dependent claim. 35 U.S.C. § 112 ¶ 5; 37 C.F.R. § 1.75(c); MPEP § 608.01(n), part (I)(B)(1). Answer (B) alone is incorrect because, even though canceling the claim will overcome the rejection, it will also leave the application without a claim to the Ethernet cable made using the processes set forth in either Claim 1 or Claim 2. Answer (C) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B and C, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, C, and D.

Answer (D) alone is not the most correct answer because even though canceling Claim 3 will overcome the rejection and provides protection for the Ethernet cable made by the process comprising the steps A, B, C, and D, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, and C.

Petitioner argues that answer (C) is also correct. Petitioner contends that answer (C) provides the same breadth as (E), namely claim 4 and that claim 5 in (E) is more narrow than claim 4 and therefore not relevant to breadth of protection.

Petitioner's arguments have been fully considered but are not persuasive. Contrary to petitioner's statement that answer (C) provides the same breadth as (E), namely claim 4 and that claim 5 in (E) is more narrow than claim 4 and therefore not relevant to breadth of protection, it will also leave the application without a claim to the Ethernet cable made using the processes comprising the steps of A, B, C, and D, which is the breadth applicant needed from cancelled claim 3 as depending from claim 2. Accordingly, model answer (E) is correct and petitioner's answer (C) is incorrect.

No error in grading has been shown. Petitioner's request for credit on this question is denied.

**ORDER**

For the reasons given above, one point has been added to petitioner's score on the Examination. Therefore, petitioner's score is 65. This score is insufficient to pass the Examination.

Upon consideration of the request for regrade to the Director of the USPTO, it is ORDERED that the request for a passing grade on the Examination is denied.

This is a final agency action.

A handwritten signature in black ink, appearing to read 'R. Spar', is positioned above a horizontal line.

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Robert J. Spar  
Director, Office of Patent Legal Administration  
Office of the Deputy Commissioner  
for Patent Examination Policy